

REMARKS/ARGUMENTS

The Office Action dated April 23, 2003 has been carefully reviewed, and these remarks respond to that Office Action. Applicants respectfully request reconsideration and allowance of the instant application.

I. General Remarks Regarding The Content Of This Amendment

Claims 1-53 and 64-73 are pending in this application. Claims 1-44 and 46-53 remain in their original form. Claim 45 is amended so that substituents X and Y correspond to elected Group I identified in the January 13, 2003, Restriction Requirement (note also that the new formula in claim 45 corresponds to the formula present in original claims 1 and 21). Original claims 54-63 are canceled without prejudice or disclaimer by this Amendment. Support for new claims 64-73 can be found in the original specification, for example, on page 7, lines 3-8 after the illustrated formula (Paragraph 15); in the sentence bridging pages 13 and 14 (Paragraph 27); and on page 17, lines 11-13 (Paragraph 43). Accordingly, no new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

II. General Remarks Regarding The Restriction Requirement

While Applicants do not necessarily agree with the Restriction Requirement, particularly with respect to claims 45-53, in order to expedite prosecution and to facilitate allowance of this application, claims 45-53 are amended herein consistent with the January 13, 2003, Restriction Requirement and Applicants' February 5, 2003 election of Group I. Additionally, non-elected claims 54-63 are canceled without prejudice or disclaimer by this Amendment. Because the non-

elected subject matter from Groups II to VII is canceled by this Amendment, the Restriction Requirement is moot (although the Election of Species Requirement remains in force).

III. The Specification Enables And Fully Supports The Subject Matter Of Claims 1-4, 21-24, 45, 46, And 49

Claims 1-4, 21-24, 45, 46, and 49 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking sufficient “enablement for all compounds (supported and unsupported) encompassed by the instant claims.” Applicants respectfully traverse this rejection and request its reconsideration.

It is well established that Applicants are entitled to a presumption of enablement. *In re Brana*, 34 USPQ2d 1436 (Fed. Cir. 1995). Specifically:

[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. (emphasis added).

In re Marzocchi and Horton, 169 USPQ 367, 370 (C.C.P.A. 1971). The Office Action fails to provide a single technical reason or a hint of objective evidence to rebut the presumption of enablement relating to Applicants’ claimed invention. Instead, the Office observes that “Applicants have only provided a very limited number of examples of supports and articles encompassed by the instant claims” (Office Action at page 5). The Office offers this one observation as allegedly bearing on the 6th and 7th of the so-called *Wands* factors. Additionally, the Office alleges that the subject matter of this invention is unpredictable and that practicing the full scope of the claimed invention would involve “undue experimentation” because the

specification allegedly fails to provide “sufficient guidance” as to which compounds within the claim scope may be useful as oligonucleotide synthesis supports as described in the specification.

While making these broad and general assertions of inadequacies, the Office offers absolutely no acceptable evidence or scientific reasoning to back up its assertions, as required by *Marzocchi*. The Office’s contention that “Applicants have only provided a very limited number of examples of supports and articles” is totally irrelevant. It is manifest that no working examples are required to satisfy the enablement requirement, let alone examples directed to every claimed radical group. *In re Fouché*, 169 USPQ 429, 434 (C.C.P.A. 1971).

Moreover, the content of Applicants’ specification provides more than ample guidance in how to make and use compounds within the scope of the claimed invention. Specifically, Figs. 2-3 of the application and their corresponding description at pages 19-34 of the specification describe general reaction schemes and conditions for producing compounds according to the invention, as well as several specific examples. Given this generalized and specific information and guidance, a person of ordinary skill in the art (which the Office admits to be a high level of skill) would be capable of producing other compounds within the scope of the claims without resorting to undue experimentation.

Applicants’ specification, however, does not stop at the above-noted information and guidance indicating how to make compounds according to the claimed invention. Rather, in conjunction with Figs. 4-5, Applicants’ specification also provides generalized reaction schemes and conditions, as well as specific examples, for using compounds according to the invention as supports for oligonucleotide synthesis. Note, for example, pages 34-43 in Applicants’ specification. Given this generalized and specific information and guidance, a person of

ordinary skill in the art, using routine experimentation, would be capable of determining whether compounds falling within the scope of the claims are useful as supports in oligonucleotide synthesis.

Notably, the Office does not cite any objective evidence showing that even a single claimed compound would not be capable of use as a support in oligonucleotide synthesis. Rather, the Office merely asserts that because of the unpredictability nature of chemical inventions and an alleged lack of “guidance” in the specification, the “undue experimentation” *Wands* factor is satisfied. The key to a rejection based on lack of enablement is whether *undue* experimentation is required. Undue experimentation is not required to produce various support materials falling within the scope of Applicants’ claims and to determine whether such support materials are useful in oligonucleotide synthesis, because Applicants’ specification generally and specifically describes procedures for doing so.

In summary, Applicants respectfully submit that the Office’s position regarding the number of examples is not a well-founded legal position. Rather, the Office improperly tries to shift the burden to Applicants to demonstrate that the claims are enabled, without first providing the legally required, objective evidence to question the asserted enablement of the claimed compounds. The rejection therefore completely ignores the presumption of enablement to which Applicants are entitled. *In re Brana*, 34 USPQ2d 1436 (Fed. Cir. 1995).

In any event, Applicants respectfully submit that the points raised herein illustrate that the claims are enabled, and the rejection is traversed. For all of the above reasons, Applicants submit that the present claims are enabled by the specification and respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

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Reply to Office Action of April 23, 2003

IV. Conclusion

Applicants believe that no fee is required for this submission. However, if any fees are required, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees.

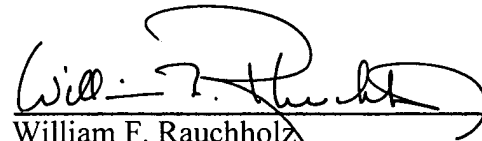
All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for immediate allowance and respectfully solicits prompt notification of the same.

Respectfully submitted,

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